REMARKS

Claims 1 to 38 are pending. Claims 1-5, 8-14 and 17-29 are rejected. Claims 30 to 38 have been withdrawn from consideration. Claims 6, 7, 15 and 16 are objected to.

§ 103 Rejections

Applicants respectfully submit that according to MPEP 2142, to establish a case of prima facie obviousness, three basic criteria must be met: 1) there must be some suggestion or motivation, either in the references or generally known to one skilled in the art, to modify or combine reference teachings, 2) there must be reasonable expectation of success, and 3) prior art references must teach or suggest all the claim limitations. The ability to modify the method of the references is not sufficient. The reference(s) must provide a motivation or reason for making the changes. *Ex parte Chicago Rawhide Manufacturing Co., 226 USPQ 438 (PTO Bd. App. 1984).*

Claims 1-5, 9, 12-14, 18-21, 24, 25 and 28-29 stand rejected under 35 USC § 103(a) as being unpatentable over McHugh (US 5,286,207) in view of Lewis (US 5,492,481) and Yamamoto et al. (WO009710691A1).

The Office Action states in part:

> McHugh fails to teach the use of a monolithic ejection mechanism. Though McHugh teaches an ejection mechanism that is made of several components, it would have been obvious at the time the invention was made, to make an integral/monolithic mechanism, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893).
>
> Lewis teaches a monolithic ejector mechanism 206 that is coupled to the body/frame and push arm/button (FIG. 11A). The mechanism slides against the body as it is rotated on and around aperture 244 of the frame/body, and therefore is in a necessarily sliding/pressing relationship with the frame/body. Re claim 2, Lewis also teaches the ejector includes a pivot cam to slide against the body so that movement of the button relative to the body causes the mechanism to pivot about the pivot cam to eject the card (FIG. 11A) where the pivot 246 are interpreted as the pivot cam that slides against the body. Re claims 6 and 15, Lewis teaches the body includes a curved portion to receive and slide the pivot cam, as discussed above through hole 244. Re claim 16, the pivot cam has a curved outer surface that has roughly the same radius as the outer surface as the body it engages (FIG. 11A).
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> At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of McHugh with those of Lewis.
>
> One would have been motivated to do this to create an integral ejection mechanism, as is well known and conventional in the art, and has the predicted results of reducing the number of independent parts/cost/assembly, while facilitating ejection of the card under various circumstances and orientations (left/right).
>
> McHugh/Lewis are silent to the ejector mechanism having a protrusion that slides against the wall of the body, including a pivot cam.
>
> Yamamota et al. teaches such a one-piece ejector mechanism 68 with a protrusion (FIG. 3) that slides against the wall (interpreted as a cam).

> At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of McHugh/Lewis with those of Yamamota.
>
> One would have been motivated to do this to have a protrusion to assist in rotational/pivotal movement (fulcrum) to eject the card.

Applicants respectfully submit that the references cannot support a case of *prima facie* obviousness as to the amended claims because, among other possible reasons, the cited references do not provide a motivation or suggest for an integral ejector mechanism or a protrusion on the ejector mechanism that slides against a wall of the body because the ejector mechanisms of the various references operate by different means.

The Examiner states that "it would have been obvious at the time the invention was made, to make an integral/monolithic mechanism, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893)." However, the Examiner has not explained how the one piece formed from the two-piece ejector mechanism of McHugh would move. As stated in *Ex Parte Hartmann*, 186 USPQ 366, 367 (PTO Bd. App. 1974), References cannot be properly combined with each other when such would result in destroying that on which the invention of one of the references is based.

The Examiner also does not indicate where on the monolithic ejector mechanism the protrusion would be located. Applicants have to assume the protrusion would be on lever 62, because it is the element of the McHugh ejector mechanism that pivots. However, the Examiner's does not explain how a protrusion would assist in rotational/pivotal movement (fulcrum) to eject the card without a wall against which the protrusion will slide. McHugh states that "the main plane 68 [of lever 62] is intentionally positioned on the top of the connector housing 12 . . .." McHugh at col. 5, lines 53-55. McHugh does not disclose a wall against which a protrusion could slide. In fact, McHugh discloses a recess: "To facilitate the rotation of the lever under the situation of structural configuration limitations, . . . there is a recess 67 disposed on the top of the main body 14 (FIG. 4) for receiving the portion around the opening 70 of the lever 62 when the card is inserted within the recess 38 of the connector housing." McHugh at col. 5, line 62 to col. 6, line 2. As indicated by this disclosure, if there were a wall, the card could not be fully inserted.

As taught by *Ashland Oil, Inc. v. Delta Resins & Refractories*, 776 F.2d 281,227 USPQ 657 (Fed. Cir. 1985), to combine references(A) and (B) properly to reach the conclusion that the subject matter of a patent would have been obvious, case law requires that there must be some teaching, suggestion, or inference in either reference (A) or (B), or both, or knowledge generally available to one of ordinary skill in the relevant art that would lead one skilled in the art ot combine the relevant teachings of references (A) and (B). Consideration must be given to teachings in the references that would have led one skilled in the art away from the claimed invention. A claim cannot properly be used as a blueprint for extracting individual teachings from references. Applicants submit that the Examiner is using improper hindsight, using the present claims as a blue print, to pick and choose elements from various references.

Furthermore, there could be no reasonable expectation of success. The Examiner asserts that it would be obvious to form the several components of the McHugh ejector mechanism into one piece. However, it is apparent from reviewing the figures of McHugh that if the components of the McHugh ejector mechanism were formed into one piece, the ejector mechanism could not move because lever portion 62 would not be able to pivot. Further adding the protrusion of Yamamoto would not provide an expectation of success because it would not allow the McHugh/Lewis ejector mechanism to pivot or move. In addition, even if the monolithic ejector mechanism of McHugh/Lewis could move, there is no wall in the McHugh structure against which the protrusion would pivot or slide.

For these reasons, Applicant(s) submit that the cited references will not support a 103(a) rejection of the claims invention and request that the rejection be withdrawn.

Claims 8, 17, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McHugh/Lewis/Yamamota et al., further in view of Broschard, III et al. (US 5,389,001).

Applicants incorporate by reference their response, above, to the rejection based on McHugh in view of Lewis and Yamamoto. Applicants further submit that the combination of McHugh, Lewis, Yamamoto and Broschard cannot support a case of *prima facie* obviousness as to the claims because, among other possible reasons, the cited references, in combination, do not provide a motivation or suggestion for a protrusion on the ejector mechanism that slides against a

wall of the body. In addition, the addition of Broschard does not make up for the deficiencies of McHugh, Lewis, and Yamamoto as a basis for an obviousness rejection.

For these reasons, Applicant(s) submit that the cited references will not support a 103(a) rejection of the claims invention and request that the rejection be withdrawn.

Claims 10-11,26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over McHugh/Lewis/Yamamoto et al., further in view of Okubo et al. (US 5,151,989).

Applicants incorporate by reference their response, above, to the rejection based on McHugh in view of Lewis and Yamamoto. Applicants further submit that the combination of McHugh, Lewis, and Okubo cannot support a case of *prima facie* obviousness as to the claims because, among other possible reasons, the cited references, in combination, do not provide a motivation or suggestion for a protrusion on the ejector mechanism that slides against a wall of the body. In addition, the addition of Okubo does not make up for the deficiencies of McHugh, Lewis, and Yamamoto as a basis for an obviousness rejection.

For these reasons, Applicant(s) submit that the cited references will not support a 103(a) rejection of the claims invention and request that the rejection be withdrawn.

In addition to the foregoing arguments, Applicant(s) submit that a dependent claim should be considered allowable when its parent claim is allowed. *In re McCairn*, 1012 USPQ 411 (CCPA 1954). Accordingly, provided the independent claims are allowed, all claims depending therefrom should also be allowed.

Based on the foregoing, it is submitted that the application is in condition for allowance.

Withdrawal of the rejections under 35 U.S.C. 103 is requested. Examination and reconsideration of the claims are requested. Allowance of the claims at an early date is solicited.

Respectfully submitted,

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